

REMARKS

This Amendment is submitted preliminary to the issuance of an Office Action in the present application and in response to the Official Action of February 1, 2008.

Claims 1-15 are pending in the application. Claims 1, 13 and 15 have been canceled. Claims 2, 9, 11, and 14 have been amended. Amended claim 11 includes the subject matter of canceled claim 15. Claim 16 has been added and recites more succinctly the subject matter of canceled claim 1 and also includes the subject matter of canceled claim 15. Support for additional subject matter included in claims 1 and 11 can be found in paragraph [0026] of the original specification. Claims 2-12, 14 and 16 remain in the application.

DOUBLE PATENTING

A terminal disclaimer is no longer required, because US application Serial No. 10/822,224 is no longer pending.

CLAIM REJECTIONS – 35 U.S.C. §103

Claims 1-12 and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over US Patent 6,785,730 to Taylor in view of US published application 2001/0025322 to Song et al. (hereafter "Song"), and further in view of US Patent 7,035,634 to Mead et al. (hereinafter "Mead").

Claims 13 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Taylor in view of Song and Mead, and further in view of Official Notice.

As admitted in the Office Action, Taylor, Song and Mead, taken either alone or in combination, do not explicitly teach or suggest if the data are transmitted in markup data transmission or binary data transmission. The examiner took Official

Notice that data can be transmitted with markup data transmission or binary data transmission.

However, this is not the essence of the invention. Claim 16 and similarly claim 11, as amended herein (as well as examined claim 15, now canceled) clearly state that “the at least one automation device and the data conversion unit exchange data and quality data by configuring the data for either markup data transmission or binary data transmission depending on the quality data and ease of conversion between the first and second communication protocol in the data conversion unit, wherein the data are exchanged according to the second communication protocol between the data conversion unit and the remote unit depending on the quality data by using one of polling, an endless HTML page or a bidirectional HTTP communication

The quality data transmitted with the first communication protocol and the ease of conversion between the first and second communication protocol in the data conversion unit therefore determine automatically, which of several data transmission modes is to be used for data transmission between an automation device and the data conversion unit with the first communication protocol, and also which of several data transmission modes is to be used for data transmission between the data conversion unit and the remote unit with the second communication protocol.

The disclosed system has to strike a balance between ease of conversion between the first and second communication protocol in the data conversion unit, which would favor data transmission with the first communication protocol using markup language, and use of binary data in the first communication protocol because binary data are of much smaller size than markup data which are text-based. The quality data will then automatically determine which data format to use in order to optimize the transmission.

Applicant therefore submits that Taylor, Song, and Mead taken either alone or in combination, fail to teach or reasonably suggest at least “transmitting quality data in the first transmission protocol, and deciding based on the quality data how data are to be transmitted between the automation device and the data conversion

unit by using the first communication protocol, and between the data conversion unit and the remote unit by using the second communication protocol." Moreover, while the Official Notice states that data can be transmitted in different transmission formats, the Official Notice fails to substantiate the conditions under which such transmission formats are selected, as is now clearly stated in amended claims 11 and 16.

For the reasons set forth above, it is applicant's contention that neither Taylor nor Song, nor Mead, nor any combination thereof teaches or suggests the features of the present invention, as recited in claims 11 and 16.

As for the rejection of the retained dependent claims, these claims depend on claims 11 and 16, respectively, share their presumably allowable features, and therefore it is respectfully submitted that these claims should also be allowed.

Withdrawal of the rejection under 35 U.S.C. §103(a) and allowance of claims 2-12, 14 and 16 are thus respectfully requested.

INFORMATION DISCLOSURE STATEMENT

It is noted that the Examiner has not considered the German reference DE 19904331, the publication "Fluidtechnik von A-Z" and "Profibus aus Wikipedia", as submitted with applicant's Third Information Disclosure Statement of November 30, 2007, *"because there were no English translation of those documents"*. Applicant respectfully disagrees with the Examiner's interpretation of 37 C.F.R. §1.98, and draws the Examiner's attention to Section 609 of the MPEP. As stated therein, the minimum requirements for information to be considered includes (1) a list of the information submitted, (2) a legible copy, and (3) a concise explanation of the relevance, whereby the concise explanation may be either separate from the specification or incorporated therein. It further sets forth that *"once the minimum requirements are met, the examiner has **an obligation** to consider the information."* [emphasis added].

It is applicant's contention that these requirements have been met by the Information Disclosure Statement as previously filed. Applicant filed PTO-Form

1449 which lists the information submitted and provided a legible copy thereof. A concise explanation of the information is set forth in the specification. The Examiner's attention is drawn in this context to page 2, 4th para. and page 3, 2nd para. of the Information Disclosure Statement, which passages provide concise explanations of these documents. Please note that while a translation of a non-English document may be submitted if readily available, the submission of a translation is not a requirement to comply with 37 C.F.R. §1.98.

For the reasons set forth, applicant respectfully requests that the Examiner reconsiders his refusal and considers the submitted information. Applicant submits herewith a new form PTO-1449. The Examiner is requested to initial the attached form PTO-1449 and to return a copy of the initialed document to the undersigned as an indication that the reference has been considered and made of record.

CONCLUSION

In view of the above, each of the presently pending claims in this application is considered patentably differentiated over the prior art of record and believed to be in immediate conditions for allowance. Reconsideration and allowance of the present application are thus respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

By: 

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